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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,070	03/08/2002	Ernst Gerber	753-11 PCT/US	8511

7590

02/20/2003

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EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,070

Applicant(s)

GERBER, ERNST 

Examiner

Erica E Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Faxing of Responses to Office Actions

1. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9302 or, for responses after final rejection only, to (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it improperly claims benefit under 35 USC 119 (a)-(c) of PCT/CH00/00501. Note that the present application was filed under 35 USC 371 as being the national stage application of PCT/ CH00/00501, and that the notice of acceptance of the present application under 35 USC 371 (paper number 4) was mailed on May 21, 2002. The present application thus may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See MPEP §1893.03(c).

Additionally, on page 1 of the declaration, the declaration sets forth that the specification is both "attached hereto" and "was described and claimed in PCT International Application No.

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PCT/CH00/00501 filed on 18.9.00 and as amended under PCT Article 19 on 8.10.01 & 14/01/02". Since only one of these boxes is supposed to be checked, this renders it unclear which the correct box is in this case. It appears that only box "C" should have been checked (regarding the application being described and claimed in the PCT).

Additionally, it is noted that two amendments are described in the aforementioned box "C". It is noted that no amendment dated 14/01/02 could be found in the instant case. As best understood, the substitute specification submitted by Applicant incorporates all indicated amendments, and this is the specification (including claims) that is being considered by the Examiner.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 sets forth a "tool holder for thermally shrinking tools and machine parts".

However, as set forth in the disclosure, the tool holder does not actually perform the claimed

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function of “thermally shrinking”. Note that the application of heat by a separate apparatus followed by cooling is what performs the claimed function of “thermally shrinking” (see p. 1, second paragraph, for example).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. Examples of this are: “the bore” in claim 1, line 2; “the tool shank” in claim 1, line 2; and “the part” in claim 1, line 2 (previously claimed plural parts). This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

The terms “low” in claim 2 and “firmly” in claim 5 are relative terms which render the claims indefinite. The terms “low” and “firmly” are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-5, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-41807 (hereinafter '807).

'807 teaches a spindle 10 or "holder" having a bore into which a ceramic sleeve 11 is fitted and held via a thermal shrink fit (see English abstract, Figures 1-3). A tool holder is inserted into the bore 11c of the sleeve 11 (Figures 1-3, English abstract), and the sleeve "holds" the tool holder (and thus the tool held thereby) therein (see English abstract). As best understood, the ceramic constitutes a material with "low thermal conductivity". Additionally, it is noted that the diameter of the sleeve bore 11c is such that it permits a smaller diameter tool to be held than would otherwise be held by the bore of the "holder" 10, and thus is considered a "reducing" sleeve". Since the sleeve can be removed (English abstract, Figures 1-3), it is "interchangeable". Additionally, since the sleeve 11 is affixed to the "holder" 10 via a shrink fit and screws or bolts 13, the sleeve is considered to be "firmly" fixed to the holder 10.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No.'s 6,260,858 and 5,311,654 teach shrink-fitted sleeves. Note that '858 teaches a ceramic sleeve. Additionally, U.S. Pat. No.'s 4,516,787, 5,267,384, and 5,277,435 all teach tool holders that have sleeves and shrink-fitting.

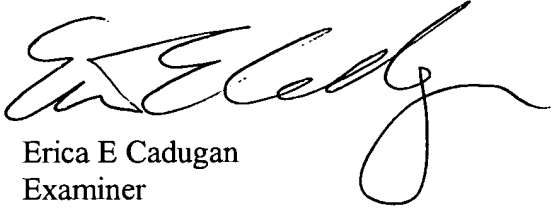
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on M-F, 7:30 a.m. to 5:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Erica E Cadugan
Examiner
Art Unit 3722

eec
February 13, 2003